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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,598	07/12/2001	Toshiya Kanesaka	S004-4327	2220

7590 09/09/2004

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,598

Applicant(s)

KANESAKA ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Claim Objections

1. Claim 30 is objected to because of the following informalities: There is insufficient antecedent basis for the limitation, 'the steps', in these claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 41 and 53 recite the limitation "the portable terminal". There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 30, 35-42, 42, 46-49, 51, and 62-66 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,587,835 by Treyz et al, hereinafter Treyz.

Regarding claim 30, Treyz discloses a method of providing service information through a mobile communication device (see Abstract; see Figures 82-84; column 50, lines 13-62), comprising steps of transmitting service information (e.g. logos, advertisements, and other

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interactive and promotional content) to a mobile communication device during a main communication process performed by the mobile communication device (a user searching through a shopping list directory); allowing a user to decide whether or not to output the service information from the mobile communication device (the user deciding to select a logo); and outputting the service information from the mobile communication device when the user has decided to output the service information (the service information is displayed on the screen).

Regarding claim 35, a method of providing service information according to claim 30, wherein Treyz further discloses the steps of transmitting the service information to the mobile communication device and outputting the service information from the mobile communication device are performed during a predetermined cycle of the main communication process (column 50, lines 20-38).

Regarding claim 36, a method of providing service information according to claim 30, wherein Treyz further discloses further comprising the steps of computing an amount to be paid by the user for the main communication, inherently reducing the amount to be charged to the user to zero if the user has decided to output the service information during the main communication process, and inherently charging a service information provider the amount corresponding to the charge for communication (column 50, lines 48-53; column 51, lines 27-43; column 57, line 20 – column 58, line 36).

Regarding claim 37, a method of providing service information according to claim 30, wherein Treyz further discloses further comprising the steps of computing an amount to be paid by the user for the main communication, discounting the charge for the main communication to be paid by the user if the user has decided to output the service information during the main

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communication process, and inherently charging a service information provider the amount corresponding to the discount in the charge for the main communication (column 50, lines 48-53; column 51, lines 27-43; column 57, line 20 – column 58, line 36).

Regarding claim 38, a method of providing service information according to claim 30, wherein Treyz further discloses further comprising the step of adding a point for offering a privilege to the user when the user has decided to output the service information during the main communication process (column 11, line 57 – column 12, line 10; column 14, line 47 – column 15, line 2).

Regarding claim 39, a method of providing service information according to claim 30, wherein Treyz further discloses further comprising the steps of inherently transmitting the service information as speech information to the mobile communication device; and causing the mobile communication device to announce the service information if the main communication process is a process of communication using text or an image (column 16, line 56 – column 17, line 10; column 31, lines 48-53; column 50, lines 20-38).

Regarding claim 40, a method of providing service information according to claim 30, wherein Treyz further discloses the service information comprises at least one of an advertisement, a quiz, a questionnaire, a prize competition, and information from a portable telephone company (column 50, lines 20-38).

Regarding claim 41, a method of providing service information according to claim 40, wherein Treyz discloses the mobile communication device comprises a cellular telephone (column 9, lines 56-63).

Regarding claim 42, please see the rejection of the method in claim 30 above to

reject the system in claim 42.

Regarding claims 46-49 and 51, please see the rejections of the method in claims 36, 37, 38, 35, and 39 above, respectively, to reject the system in claims 46-49 and 51.

Regarding claims 52-53, please see the rejections of the method in claims 40-41 above, respectively, to reject the system in claims 52-53.

Regarding claim 62, Treyz discloses a mobile communication management server comprising: service information receiving means for receiving service information from a service information provider; and service information transmitting means for transmitting service information to a mobile communication device during a main communication process performed by the mobile communication device (see Abstract; column 9, lines 56-63; column 10, lines 16-19; column 12, lines 28-33; see Figures 82-84; column 50, lines 13-62).

Regarding claim 63, a mobile communication management server according to claim 62, wherein, Treyz further discloses the mobile communication device comprises a cellular telephone (column 9, lines 56-63).

Regarding claim 64, a mobile communication management server according to claim 63, wherein Treyz further discloses the service information comprises at least one of an advertisement, a quiz, a questionnaire, a prize competition, and information from a portable telephone company (column 50, lines 20-38).

Regarding claim 65, a mobile communication management server according to claim 63, wherein Treyz further discloses further comprising service information accumulation means for accumulating service information to be transmitted to the mobile communication device (column 10, lines 16-19; column 50, lines 13-62).

Regarding claim 66, a mobile communication management server according to claim 63, wherein Treyz further discloses further comprising service information acquisition means connected to a provider server which manages a service information provider, in which service information to be transmitted to the mobile communication device is accumulated, the service information acquisition means for obtaining service information from the server and for transmitting the service information to the mobile communication device (column 10, lines 16-19; column 50, lines 13-62).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz, as applied to claim 30 above, in view of U.S. Patent No. 6,263,318 by Kita.

Regarding claim 31, a method of providing service information according to claim 30, wherein Treyz further discloses further comprising the steps of transferring the service information from the mobile communication device to a terminal (e.g. a store's cash register) capable of direct communication with the mobile communication device (column 51, lines 27-43).

Treyz does not disclose transferring the service information from the mobile communication device to a portable terminal and outputting the service information from the portable terminal.

Kita discloses an incoming calling system to securely notify the user of the incoming to a radio portable terminal of a mobile communication unit or the like without disturbing others (see Abstract; see Figures 1-2). When an incoming call signal is detected via the portable telephone (Figure 1, 21) of the user, the signals are transmitted to a portable terminal or wrist watch. The incoming call signal is outputted from the portable terminal to notify the user of an incoming call by vibration, sound, or light (column 4, lines 25-64; column 13, line 50 – column 14, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Treyz to include transferring the service information from the mobile communication device to a portable terminal and outputting the service information from the portable terminal as taught by Kita. One of ordinary skill in the art would have been lead to make such a modification in order to forward the information to a display on a portable terminal that is visible to the user.

Regarding claim 32, a method of providing service information according to claim 31, wherein Kita further discloses the mobile communication device comprises a cellular telephone (Figure 1, 21) and the portable terminal comprises a wrist-wearable device (Figure 1, 27; column 4, lines 25-35).

Regarding claim 33, a method of providing service information according to claim 31, wherein Treyz further discloses further comprising the steps of transmitting the service information as text or image information to the mobile communication device (column 50, lines

20-38); and displaying the service information on the portable terminal if the main communication process is inherently a process of telephone communication using speech. (column 16, lines 56-63).

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz in view of U.S. Patent No. 6,263,318 by Kita as applied to claim 31 above, and further in view of U.S. Patent No. 6,640,115 by Fujimoto et al, hereinafter Fujimoto.

Regarding claim 34, a method of providing service information according to claim 31, wherein Treyz further discloses the step of allowing a user to decide whether or not to output the service information comprises the step of determining whether the user has performed a predetermined confirmation operation (column 50, lines 54-58; column 51, lines 27-35).

Treyz does not disclose the step of determining whether the user has performed a predetermined movement confirmation operation detected by an acceleration sensor provided in the portable terminal.

Fujimoto discloses controlling an incoming call response operation on the basis of the movement speed of a portable terminal or radio telephone apparatus (see Abstract). A control circuit or acceleration sensor can determine that the radio telephone apparatus is moving at high speed or low speed (column 7, line 54 – column 8, line 10). A response operation is performed in accordance with the movement speed of said apparatus (column 9, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Treyz to include a portable terminal that has a control circuit as taught by Fujimoto in order to determine when to output service information on said terminal. One of ordinary skill in the art would have been lead to make such a modification since a user

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can determine when to have service information outputted on said terminal by confirming the acceleration of said terminal by a control circuit. The control circuit determines when said terminal is moving at high or low speed.

9. Claims 43, 44, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz, as applied to claim 42 above, in view of U.S. Patent No. 6,263,318 by Kita.

Regarding claims 43, 44, and 50, please see the rejections of the method in claims 31, 32, and 33 above, respectively, to reject the system in claims 43, 44, and 50.

10. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz in view of U.S. Patent No. 6,263,318 by Kita as applied to claim 43 above, and further in view of U.S. Patent No. 6,640,115 by Fujimoto et al, hereinafter Fujimoto.

Regarding claim 45, please see the rejection of the method in claim 34 above, to reject the system in claim 45.

11. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz in view of U.S. Patent No. 6,263,318 by Kita.

Regarding claim 54, please see the rejection of the method in claims 30 and 31 above, respectively, to reject the combination in claim 54.

Regarding claims 55-56, please see the rejections of the method in claims 41 and 40 above, respectively, to reject the combination in claims 55-56.

12. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz in view of U.S. Patent No. 6,263,318 by Kita.

Regarding claim 57, please see the rejection of the method in claims 30 and 31 above,

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respectively, to reject the portable terminal in claim 57.

Regarding claims 58-59, please see the rejections of the method in claims 41 and 40 above, respectively, to reject the portable terminal in claims 58-59.

Regarding claim 60, please see the rejection of the method in claim 30 to reject the portable terminal in claim 60.

13. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,587,835 by Treyz in view of U.S. Patent No. 6,263,318 by Kita as applied to 57 above, and further in view of U.S. Patent No. 6,640,115 by Fujimoto et al, hereinafter Fujimoto.

Regarding claim 61, please see the rejection of the method in claim 34 above, to reject the portable terminal in claim 61.

Response to Arguments

14. Examiner acknowledges the cancellation of claims 1-29 in the Amendment filed on June 14, 2004.

15. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus the claim limitations in the examined claims above that employ phrases of type: “FOR” doing something, e.g. ‘text and image selection means for’, ‘means for communication with other communication devices’, etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted above have the structure and functions of performing the claimed limitations.

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16. Applicant's arguments with respect to claims 30-66 have been considered but are moot in view of the new ground(s) of rejection.

17. Accordingly, **THIS ACTION IS MADE NON-FINAL.**

Conclusion

18. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

September 7, 2004


ALLAN HOOSAIN
PRIMARY EXAMINER